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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,319	09/16/2003	Alexander Vincent Danilo	00169.002728	9258

5514 7590 08/21/2007
FITZPATRICK CELLA HARPER & SCINTO
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NEW YORK, NY 10112

EXAMINER

DHINGRA, PAWANDEEP

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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08/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/662,319	Applicant(s) DANILO, ALEXANDER VINCENT	
	Examiner Pawandeep S. Dhingra	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/6/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 6, 8 and 12 is/are pending in the application.
- 4a) Of the above claim(s) 1, 3, 4-5, 7, 9-11, and 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 6, 8 and 12 is/are rejected.
- 7) ☒ Claim(s) 2, 8, and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7/18/2006, 11/30/2004, 04/08/2004.

DETAILED ACTION

- This action is responsive to the following communication: a Response to Election/Restriction filed on 08/06/2007.
- Claims 1, 3, 4-5, 7, 9-11, and 13-15 have been non-elected in the present application.
- Claims 2, 6, 8, and 12 (based on Species II) are now pending, and are being examined on the merits in response to the election made with traverse by the applicant in the present application.

Drawing Objections

Figures 1-2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (see pages 1-4 of applicant's disclosure). See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 2, 8, and 12 are objected to because of the following informalities:

In Claims 2, 8, and 12, under part a) "categorising" should be changed to "categorizing".

Applicant must review entire claim section for such errors and appropriate corrections are required.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 12 is drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Claim 12, while defining a computer program, does not define a "computer-readable medium" and is thus non-statutory for that reasons. A computer program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to recite "a

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computer readable medium storing a computer program for causing the computer to execute" in order to make the claim statutory.

"In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

Examiner Notes

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 2, 6, 8, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Politis, US 5,724,494.

Re claim 2, Politis discloses a method of converting a representation of a first image (see abstract), having a first set of overlapping graphic objects, into a display list representation of a visually equivalent second image, having a second set of non overlapping graphic objects (see abstract, figure 3-4; column 2, lines 34-55), said method comprising the steps of: (a) categorising each graphic object in the first set as being one of (i) a fully visible graphic object (see figures 4, 10-14, 17, 30-33), (ii) a partly visible graphic object (see figures 4, 10-14, 17, 30-33), and (iii) an invisible graphic object (see column 15, lines 5-10; column 17, lines 8-20; figures 4, 10-14, 17, 30-33); (b) defining, in relation to each said fully visible graphic object in said first set, a substantially identical graphic object in the second set (see column 12, line 10-column 15, line 10; column 8, lines 3-38; figures 4-9, 17, 30-33; claims 5-7); and (c) defining, in relation to visible regions of each said partly visible graphic object in said first set, one or more graphic objects being visually equivalent to the partly visible graphic object, in the second set (see column 12, line 10-column 15, line 10; column 8, lines 3-38; figures 4-9, 17, 30-33; claims 5-7).

Re claim 6, Politis further discloses at least one of the first set of overlapping graphic objects and the second set of non overlapping graphic objects are opaque (see column 2, lines 48-55; column 14, line 54 - column 16, line 44).

Re Claim 8, claim 8 recites identical features, as claim 2, except claim 8 is an apparatus claim. Thus, arguments made for claim 2 are applicable for claim 8.

Re Claim 12, claim 12 recites identical features, as claim 2, except claim 12 merely deals with executing the method of claim 2 on a computer. Thus, arguments made for claim 2 are applicable for claim 12.

Response to Arguments

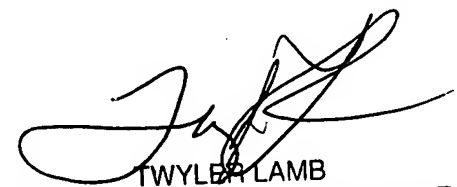
Applicant's arguments on page 1, filed 08/06/2007, with respect to the election/restriction requirement have been fully considered but they are not persuasive. Upon further consideration, the examiner still recognizes the present inventions as independent or distinct for the reasons given in the Requirement for Restriction/Election mailed 07/05/2007. The restriction for examination purposes as indicated in earlier correspondence is proper since there is all examination and search burden for the indicated patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph, and therefore would put serious burden on the examiner if restriction is not made.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pawandeep S. Dhingra whose telephone number is 571-270-1231. The examiner can normally be reached on M-F, 9:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

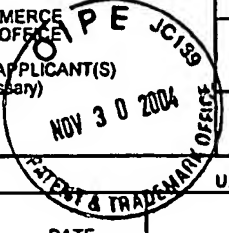

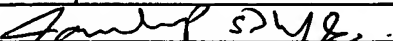
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



TWYLER LAMB
SUPERVISORY PATENT EXAMINER

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August 13, 2007

FORM PTO 1449 (modified) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE LIST OF REFERENCES CITED BY APPLICANT(S) (Use several sheets if necessary)			ATTY DOCKET NO. 00169.002728		APPLICATION NO. 10/662,319		
			APPLICANT ALEXANDER VINCENT DANILO				
			FILING DATE September 16, 2003		GROUP 2622		
U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES/NO/ OR ABSTRACT
OTHER DOCUMENT(S) (Including Author, Title, Date, Pertinent Pages, Etc.)							
		Foley, J.D., et al., "Computer Graphics Principles and Practice", Second Edition in C., Section 19.9, pp. 998-1006 (1997).					
EXAMINER					DATE CONSIDERED 8/13/07		

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Sheet 1 of 1